REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on August 30, 2000, and the references cited therewith.

Claims 3, 8, 19, 25-29 are amended. Claims 3, 19, and 25 are amended to spell out "electronic program guide" in place of the abbreviation "EPG." Claim 8, 19, and 25-29 are amended to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention, preserve the full scope of equivalents, and avoid interpretation under 35 U.S.C. §112 ¶6. Claim 19 is amended to correct a grammatical error in the preamble. None of the amendments is in response to an art rejection.

Claims 13-18 are canceled without prejudice or disclaimer.

Claims 1-12 and 19-33 remain pending in this application.

Claims Patentable over Klosterman/Alten combination under §103

Claims 1-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Klosterman et al. (U.S. Patent No. 6,078,348) in view of Alten et al. (U.S. Patent No. 5,781,246).

Applicant respectfully traverses the rejection because a *prima facie* case of obviousness does not exist. To establish a *prima facie* case of obviousness the references must teach or suggest all the claim elements. MPEP §2143. Included in elements that the Klosterman/Alten combination does not teach or suggest are: (1) directly including channels associated with a theme in a favorite channel list and (2) automatically including channels based on actual viewing or usage in a favorite channel list, as discussed below. Therefore, a *prima facie* case of obviousness has not been established. Applicant respectfully requests reconsideration and passage to allowance of the amended claims.

1.   Klosterman/Alten Fails to Teach Directly Including Channels Associated with a Theme in a Favorite Channel List

Claims 1-7 recite "one or more favorite channel lists, the favorite channel lists comprising one or more logical channels relating to the user specified theme, wherein the computerized system identifies the logical channels showing an event of the user specified theme and includes each of the logical channels in the favorite channel list," which is not taught or

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111   Page 5
Serial Number: 09/002,906   Dkt: 450.196US1
Filing Date: January 5, 1998
Title: A SYSTEM FOR MANAGING FAVORITE CHANNELS

suggested by the Klosterman/Alten combination. Klosterman is directed to searching a database for a theme input by the user and displaying the search results on a screen or tuning to the channels as they are found. (Klosterman, col. 11, lines 1-9). Klosterman does not teach including channels showing an event of the user specified theme in a favorites channel list. Alten is directed to "categorical entries" included as a name of a category in a favorite channel list. (Alten, Figure 8, element 83, col. 26 lines 34-37). As shown in Figure 8, the name of the category is included in the list, not the associated logical channels. The logical channels are not listed in the favorite channel list; they are later tuned in sequence upon user selection of the category name from the list. (Alten, col. 26, lines 37-44).

The combination of Klosterman and Alten does not teach or suggest this claim element. The claimed invention includes the logical channels associated with the user specified theme directly in the favorite channel list. This provides advantages over previous systems. Having the channels directly in the list gives the user more control. For example, once the user sees the channels included based on the theme, the user may decide to delete an undesirable channel. Alten's favorite list only permits deleting the whole theme, because it is unknown what logical channels are associated with the theme. (Alten, Figure 8, element 83). Also, the user does not have to sit through the display of each channel in sequence that matches the theme, which could be quite lengthy. (Klosterman, col. 11 lines 6-8; Alten, col. 26, lines 36-44). If it were in fact obvious, given the advantages of directly including the channels in the favorites list, those skilled in the art surely would have implemented it by now. In other words, the fact that those skilled in the art have not implemented this element, despite its advantages, indicates that it is not obvious.

Claims 8-12 and 19-29 also recite the patentably distinct element discussed above. Claims 8-12 recite "wherein the computerized system identifies the logical channels showing an event of the user specified theme and includes such logical channels in the favorite channel list." Claims 19-23 recite "identifying one or more channels showing an event of a user specified theme . . . and including each one of the channels in a favorite channel list." Claims 24-29 recite "identifying one or more channels showing an event of a user specified theme and including each one of the channels in a favorite channel list." The cited references do not teach or suggest these elements.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111
Serial Number: 09/002,906
Filing Date: January 5, 1998
Title: A SYSTEM FOR MANAGING FAVORITE CHANNELS

Page 6
Dkt: 450.196US1

2.   *Klosterman/Alten Fail to Teach Automatically Including Channels based on Actual Viewing or Usage in Favorite Channel List*

Claims 30-33 recite automatically including channels based on actual viewing or usage in a favorite channel list. Claims 30-32 recite "the computerized system monitors usage of a plurality of physical channels for a predetermined time and includes the logical channel identifier for the physical channels used most frequently in the favorite channel list." Claim 33 recites "the favorite channel lists comprising one or more logical channels, wherein the computerized system identifies the logical channels that have been viewed most often by the user." Klosterman mentions automatically ordering channels on the user's guide screen based on tracking the user's most watched channels. (Klosterman, col. 11 lines 45-54). Also, Klosterman mentions using the tracking data for marketing research purposes. (Klosterman, col. 11, lines 54-57). Klosterman does not teach or suggest including the most watched channels in a favorites list. Alten does not teach or suggest automatically including any channels in a favorite channel list. The claimed invention addresses a need for favorite channel lists that are automatically and dynamically created and updated. (Applicant's specification, page 1, lines 13-15, page 2, lines 11-12 and 25). This is more efficient and convenient for the user. The Klosterman/Alten combination does not teach or suggest this element.

For all of the above reasons, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-33.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6954) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.
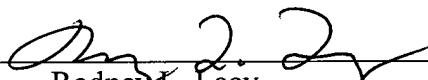
Respectfully submitted,

THEODORE D. WUGOFSKI ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER
& KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6954

Date: _____ By _____
                                       Rodney L. Lacy
                                       Reg. No. 41,136

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this ____ day of January, 2001.

_____**Candis B. Buending**_____   _____
Name   Signature